

REMARKS UNDER 37 CFR § 1.111

Formal Matters

Claims 102-113 are pending after entry of the amendments set forth herein.

Claims 102-113 were examined. Claims 102-113 were rejected.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

The Office Action

Objection to the Oath/Declaration

In the Official Action of March 17, 2008, the Oath/Declaration was objected to as being defective. The Examiner indicated that the declaration filed 7/8/2003 was not properly executed because eight inventors were listed, but only two have signed the declaration.

In response thereto, Applicants respectfully submit that a Preliminary Amendment was filed on April 27, 2004. In the Preliminary Amendment, originally filed claims 1-101 were canceled without prejudice to the possibility of filing one or more continuing applications directed to the subject matter recited therein, and new claims 102-113 were submitted. It is respectfully submitted that Liming Lau and John P. Lunsford are the inventors of claims 102-113. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the objection to the oath/declaration as being defective, as being inappropriate.

Claims Rejected Under 35 U.S.C. Section 102(e) (Sharrow et al.)

Claims 102-113 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Sharrow et al., US Patent Application Publication No. 2003/0139646. The Examiner asserted that Sharrow et al. teaches a suction member, such as suction cups 12 and 32, that may be made of silicone (paragraph [0032]) and that the compliant seal 18 or 38 may be adhesively boded or mechanically bonded to the

suction cup (paragraph [0033]). The Examiner further asserted that the seal may be silicone (paragraph [0027]) and that the seal is C-shaped as shown in Fig. 3.

Applicants have amended claim 102 above to further recite the C-shape of said compliant seal being formed around a space, wherein said seal compresses when contacted to tissue such that portions of the C-shaped seal move toward one another reducing the volume of the space. Applicants have amended claim 112 above to further recite the C-shape of said compliant seal comprising an opening leading into a space, said opening facing an external environment of said member. Support for these amendments can be found, for example at paragraph [00189] of the specification, Fig. 14B, and throughout the specification. It is respectfully submitted that the skirt-like member 38 (Fig. 2) does not surround an open space or have an opening that opens to the external environment of the cup.

Accordingly, in view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 102-113 under 35 U.S.C. Section 102(e) as being anticipated by Sharrow et al., US Patent Application Publication No. 2003/0139646, as being inappropriate.

Claims Rejected Under 35 U.S.C. Section 102(b) (Spence et al.)

Claims 102, 106-107 and 109-113 were rejected under 35 U.S.C. Section 102(b) as being anticipated by Spence et al., US Patent No. 6,338,712. The Examiner asserted that element 200 of Spence et al is a suction member, that 204 is a flexible rim (from distal end to shoulder 209) is a compliant seal having a C-shaped cross-section and the element 324 is a support structure and element 316 is a suspension.

Applicants have amended claim 102 above to further recite the C-shape of said compliant seal being formed around a space, wherein said seal compresses when contacted to tissue such that portions of the C-shaped seal move toward one another reducing the volume of the space. Applicants have amended claim 112 above to further recite the C-shape of said compliant seal comprising an opening leading into a space, said opening facing an external environment of said member. Support for these amendments can be found, for example at paragraph [00189] of the specification, Fig. 14B, and throughout the specification. It is respectfully submitted that Spence et al. does not disclose or suggest a seal having a C-shaped cross section as currently claimed.

Accordingly, in view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 102, 106-107 and 109-113 under 35 U.S.C.

Section 102(b) as being anticipated by Spence et al., US Patent No. 6,338,712, as being inappropriate.

Claims Rejected Under 35 U.S.C. Section 103(a) (Spence et al. in view of Peng et al.)

Claims 105 and 108 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Spence et al., US Patent No. 6,338,712 in view of Peng et al., U.S. Patent Application Publication No. 2002/0058856. The Examiner asserted that Spence et al. teaches a device as claimed, but does not teach the material used for the suction member or bonding the seal to the suction member. Applicants respectfully traverse. Applicants respectfully submit that Spence et al. does not disclose or suggest a seal having a C-shaped cross section as currently claimed, for at least the same reasons provided above in response to the rejection of claims 102, 106-107 and 109-113 under 35 U.S.C. Section 102(b) as being anticipated by Spence et al., US Patent No. 6,338,712. Furthermore, it is respectfully submitted that Peng et al. fails to make up for this deficiency of Spence et al., since Peng et al. also fails to disclose or suggest a seal having a C-shaped cross section as currently claimed.

Accordingly, in view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 105 and 108 under 35 U.S.C. Section 103(a) as being unpatentable over Spence et al., US Patent No. 6,338,712 in view of Peng et al., U.S. Patent Application Publication No. 2002/0058856, as being inappropriate.

Claims Rejected Under 35 U.S.C. Section 103(a) (Spence et al. in view of Sharrow et al.)

Claims 103-105 and 108 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Spence et al., US Patent No. 6,338,712 in view of Sharrow et al., US Patent Application Publication No. 2003/0139646. The Examiner asserted that Spence et al. teaches a device as claimed, but does not teach the materials used for the suction member gasket/seal or bonding/mechanically connecting the seal to the suction member. Applicants respectfully traverse. Applicants respectfully submit that Spence et al. does not disclose or suggest a seal having a C-shaped cross section as currently claimed, for at least the same reasons provided above in response to the rejection of claims 102, 106-107 and 109-113 under 35 U.S.C. Section 102(b) as being anticipated by Spence et al., US Patent No. 6,338,712. Furthermore, it is respectfully submitted that Sharrow et al. fails to make up for this deficiency of Spence et al., as noted above in response to the rejection of claims 102-113 under 35 U.S.C. Section 102(e) as being anticipated by Sharrow et al.

Accordingly, in view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 103-105 and 108 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Spence et al., US Patent No. 6,338,712 in view of Sharrow et al., US Patent Application Publication No. 2003/0139646, as being inappropriate.

Conclusion

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-032.

Respectfully submitted,
LAW OFFICE OF ALAN W. CANNON

Date: 6/17/08

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